

REMARKS

Please reconsider the application in view of the following remarks. Applicant thanks the Examiner for carefully considering this application.

Status of Claims

Claims 1-11 are pending in this application. Claims 1 and 6 are independent. The remaining claims depend, directly or indirectly, from claim 1 or 6.

Information Disclosure Statements

Applicant thanks the Examiner for indicating that the references cited with the Information Disclosure Statements, filed January 12, 2007, and March 21, 2007, were properly submitted and are being considered in the pending Office Action.

However, Applicant notes that the initialed copies of the PTO/SB/08 Form submitted with these Information Disclosure Statements, filed January 12, 2007 and March 21, 2007, were not returned. Accordingly, Applicant respectfully requests that the Examiner sign the aforementioned PTO/SB/08 Form, initial the references cited therein, and return them along with the next office paper.

Rejection(s) under 35 U.S.C. § 103

Claims 1-11 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,787,225 issued to Honjo ("Honjo") in view of U.S. Patent No. 6,925,042 issued to Nakajo ("Nakajo") in further view of U.S. Patent No. 6,961,510 issued to Proidl ("Proidl") in further

view of U.S. Patent No. 5,784,518 issued to Ogura ("Ogura"). For the reasons set forth below, this rejection is respectfully traversed.

Independent claim 1 requires, in part, "a control unit configured to control the expansion unit, *when the high speed reproduction key is operated, to reproduce the compressed video and audio data for a number of frames corresponding to the n-fold speed, alternating with reproducing the compressed video and audio data in one of a normal speed and a two-fold speed for a predetermined number of frames.*" Independent claim 6 requires, in part, "controlling the expanding, *when a high speed reproduction for reproducing the compressed video and audio data in n-fold (where $n \geq 3$) speed is selected, to reproduce the compressed video and audio data for a number of frames corresponding to the n-fold speed, alternating with reproducing the compressed video and audio data in one of normal speed and two-fold speed for a predetermined number of frames.*"

In contrast to the Examiner's assertion, Ogura fails to show or suggest at least the above limitations. In fact, Ogura only teaches that the speed of reproduction is increased from 50-fold speed to 100-fold speed (*see* Ogura, column 7, lines 17-58). Therefore, Ogura does not show or suggest that the reproduction speed is switching between n-fold speed and at least one of a normal and two-fold speed *regularly*.

Specifically, it would be clear for a skilled artisan that mere increasing a speed of a reproduction as taught by Ogura does not correspond to *alternating* between one speed and another speed during high-speed reproduction. As explained above, the instant Specification describes that when high-speed reproduction is initiated, the video information is reproduced while switching between at the designated high-speed reproduction rate and at a normal

reproduction rate *regularly* until high-speed reproduction of the digital video data is interrupted. Also, according to the dictionary definition, the meaning of the term “alternate” is “happening or following one after the other *regularly*.” The MPEP 2111.01 makes it clear that “during examination the USPTO must give claims their broadest *reasonable* interpretation *in light of the specification*” and that “the words of the claim must be given their *plain meaning*.”

Further, as shown in Figures 11 and 12 of Ogura, Ogura teaches that frames are reproduced *selectively at a fixed speed*. Specifically, Ogura teaches that when a user selects the 50-fold speed reproduction, the reproduction speed is fixed at the 50-fold speed. In order to change the reproduction speed to the 100-fold speed, a user has to select the 100-fold speed reproduction.

Accordingly, Ogura necessarily does not show or suggest at least, “a control unit configured to control the expansion unit, *when the high speed reproduction key is operated, to reproduce the compressed video and audio data for a number of frames corresponding to the n-fold speed, alternating* with reproducing the compressed video and audio data in one of a normal speed and a two-fold speed for a predetermined number of frames,” as required by independent claim 1. Also, Ogura necessarily does not show or suggest “controlling the expanding, *when a high speed reproduction for reproducing the compressed video and audio data in n-fold (where $n \geq 3$) speed is selected*, to reproduce the compressed video and audio data for a number of frames corresponding to the n-fold speed, *alternating* with reproducing the compressed video and audio data in one of normal speed and two-fold speed for a predetermined number of frames,” as required by independent claim 6.

Further, the Examiner alleges that Ogura teaches alternating between various speeds of reproduction (*see* Office Action dated April 8, 2008, at pages 3 and 6). However, as discussed above, Ogura does not teach *alternating* speeds of reproduction. Therefore, the pending Office Action has failed to establish that Ogura shows or suggests at least the above limitation as required by independent claims 1 and 6.

According to the MPEP § 2112, “[t]he fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. . . . In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.” In addition, if the Examiner is basing any part of the rejection on his personal knowledge, in accordance with 37 C.F.R. 1.104 (d)(2), Applicant hereby requests that the Examiner provide an affidavit detailing his personal knowledge for consideration and rebuttal.

In addition, as admitted by the Examiner, Honjo, Nakajo, and Proidl, fail to show or suggest that which Ogura lacks.

As explained in a previous Response dated April 27, 2007, Honjo simply teaches that the control unit 8 increases the rotation speed of the optical disk 1 by controlling a motor driving circuit 9 based on a received signals for high-speed reproduction (*see* Honjo, column 3, line 64 – column 4, line 2). That is, Honjo only teaches that the control unit 8 increases the rotation speed of the optical disk in the high-speed reproduction. Thus, the control unit 8 of Honjo is completely different from the control unit/method of the claimed invention.

Further, the apparatus of Honjo reproduces signals at the normal speed and at the high-speed *separately*. In fact, Honjo states, “[i]n a reproduction at the normal speed, the read-out video data is all decoded and output as the reproduced video signals,” and “[i]n the high-speed reproduction, among the read-out video data, only the intra-coded video data and the forward predictive coded video data are output as the reproduced video signals” (*see* Honjo, column 2, lines 27-32).

Therefore, Honjo does not show or suggest at least, during high-speed reproduction, reproducing the compressed video and audio data for a number of frames corresponding to the n-fold speed, *alternating* with reproducing the compressed video and audio data in one of a normal speed and a two-fold speed for a predetermined number of frames, as required by independent claims 1 and 6.

Moreover, Applicant respectfully submits that the Examiner, *using the present application as a guide*, has selected isolated features of the various relied-upon references to arrive at the limitations of the claimed invention. In fact, the Examiner states that “[t]he ‘alternating the compressed A/V with normal speed signals’ by the user *as described in applicant specification paragraphs 0028-0030* further supports the use of Honjo as it alternates normal and fast speed through user control” (*see* Office Action dated April 8, 2008, at pages 2-3). Thus, it is clear that the Examiner uses the present application as a guide because the Examiner clearly relies upon the present specification to provide the motivation to combine the references.

It is well settled that use of the present application as a “road map” for selecting and combining prior art disclosures is wholly improper (*see Interconnect Planning Corp. v. Feil*, 774

F.2d 1132, 1138 (Fed. Cir. 1985) (stating that “[t]he invention must be viewed not with the blueprint drawn by the inventor, but in the state of the art that existed at the time”); *In re Fritch*, 972 F.2d 1260, 1266 (Fed. Cir. 1992) (stating that “it is impermissible to use the claimed invention as an instruction manual or ‘template’ to piece together the teachings of the prior art so that the claimed invention is rendered obvious . . . This court has previously stated that ‘one cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.’”).

In addition, Applicant respectfully notes that paragraphs [0028]-[0030] of both the original Specification and the publication the Specification, which are cited by the Examiner, actually do not describe “alternating the compressed A/V with normal speed signals.” Thus, Applicant respectfully asserts that this rejection is also unclear.

Further, with respect to Nakajo and Proidl, these references, like Ogura and Honjo, do not show or suggest at least the above limitation as required by independent claims 1 and 6.

In fact, as explained in the previous Responses, Nakajo teaches a high-speed recording system. Nakajo is completely silent with respect to high-speed reproduction, as required by the claimed invention. It would be clear for one skilled in the art that reproduction of a recorded medium is an operation that occurs separately from and independent of the recording of the medium, and that the recording operation taught by Nakajo is separate and distinct from high speed reproduction of previously recorded video and audio data, as required by the claimed invention. Therefore, Nakajo fails to show or suggest at least, during high-speed reproduction, reproducing the compressed video and audio data for a number of frames corresponding to the n-

fold speed, *alternating* with reproducing the compressed video and audio data in one of a normal speed and a two-fold speed for a predetermined number of frames, as required by independent claims 1 and 6.

Further, Proidl only teaches a reproduction device 1 simply choosing one speed for reproducing, according to a recording speed during the recordation of the reproduction data on the tape (*see* Proidl, Abstract). Specifically, Proidl teaches that an automatic change-over to the second trick-play reproduction speed occurs if no valid first-trick play reproduction is reproduced during a test interval. Then, if no valid second trick-play reproduction data is reproduced during a further test interval, an automatic change-over to the third trick-play reproduction speed occurs (*see* Proidl, column 2, lines 22-31). That is, Proidl reproduces data at each speed according to the recorded speed.

Therefore, Proidl does not show or suggest at least, during high-speed reproduction, reproducing the compressed video and audio data for a number of frames corresponding to the n-fold speed, *alternating* with reproducing the compressed video and audio data in one of a normal speed and a two-fold speed for a predetermined number of frames, as required by independent claims 1 and 6.

Finally, Applicant respectfully asserts that there is no suggestion or motivation that would enable one skilled in the art to turn to this combination of references to achieve the claimed invention. Recently, the Supreme Court issued its opinion on *KSR v. Teleflex*. *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727 (2007). Although finding the teaching-suggestion-motivation test too narrow to be applied in a determination test for obviousness, the court

underscored the importance of viewing the obviousness through the eyes of one skilled in the art. Thus, even in view of *KSR Int'l Co. v. Teleflex, Inc.*, “[a]n obviousness determination is not the result of a rigid formula disassociated from the consideration of the facts of a case. Indeed, the common sense of those skilled in the art demonstrates why some combinations would have been obvious where others would not.” *KSR Int'l Co. v. Teleflex, Inc.*, 127 S.Ct. 1727, 167 L.Ed.2d 705 (April 30, 2007).

As discussed above, all the cited references fail to show or suggest at least, during high-speed reproduction, reproducing the compressed video and audio data for a number of frames corresponding to the n-fold speed, *alternating* with reproducing the compressed video and audio data in one of a normal speed and a two-fold speed for a predetermined number of frames, as required by independent claims 1 and 6. Therefore, clearly, the combination of references used by the Examiner to reject the claims of the present application is not a combination that one skilled in the art would turn to in arriving at the present invention.

In view of above, Ogura, Honjo, Nakajo, and Proidl, whether taken separately or in combination, fail to show or suggest the invention as recited in independent claims 1 and 6. Thus, independent claims 1 and 6 are patentable over Ogura, Honjo, Nakajo, and Proidl. Dependent claims are allowable for at least same reasons. Accordingly, withdrawal of this rejection is respectfully requested.

Conclusion

Applicant believes this reply is fully responsive to all outstanding issues and places this application in condition for allowance. If this belief is incorrect, or other issues arise, the Examiner is encouraged to contact the undersigned or his associates at the telephone number listed below. Please apply any charges not covered, or any credits, to Deposit Account 50-0591, Reference 04995/121001.

Applicant respectfully requests that the Examiner acknowledge the PTO's receipt of the Information Disclosure Statements filed on January 12, 2007 and March 21, 2007.

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Respectfully submitted,

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